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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(MBHB Case No. 00-591)

In re Application of: Edward M. Housel	)	Group Art Unit: 2624
Serial No.: 09/692,645	)	Examiner: King Y. Poon
Filed: October 19, 2000	)	
For: Method of Generating Printer Setup Instructions	)	

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Brief on Appeal

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Brief on Appeal

Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

An original and three copies of this appeal brief are submitted along with a fee of three hundred and twenty dollars ($320.00) for filing a brief in support of an appeal. A Notice of Appeal was filed on October 18, 2002. In the event of any variance between any of the amounts enclosed and the Patent and Trademark Office charges, please charge or credit any difference to our Deposit Account No. 13-2490.

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I. REAL PARTY IN INTEREST

The real party in interest is Heidelberg Digital, L.L.C., to which this invention is assigned.

II. RELATED APPEALS AND INTERFERENCES

Applicant is aware of no related appeals or interferences concerning this application.

III. STATUS OF CLAIMS

Claims 1, 3-5, 7-25 and 27-30 stand finally rejected. Claims 2, 6 and 26 are objected to. Claims 1-30 are the subject of this appeal. A clean set of all pending claims is attached as Appendix A.

IV. STATUS OF AMENDMENTS

There are no outstanding amendments.

V. SUMMARY OF THE INVENTION

The present invention relates to printer setup for controlling a printer having at least one attached finishing device. More particularly, it relates to a method of generating a printed instruction sheet listing setup instructions for at least one finishing device attached to a printer, thereby allowing the setup operator to carry the printed instruction sheet to a user interface of the finishing device and input the setup instructions using the

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instruction sheet rather than relying on memory to properly configure the finishing device.

A print job may be entered into a printer, and the print job may include setup instructions for at least one finishing device connected to the printer. The printer may automatically print an instruction sheet listing setup operations for the finishing device to be performed prior to completing the print job. One or more pending print jobs may be placed on hold in order to allow an operator to configure the finishing devices using the instruction sheet. After the finishing devices are configured, a release code can be used to release one or more of the print jobs from hold and allow the printer to complete the print jobs.

VI. ISSUES PRESENTED

The issues presented to the Board for review by this appeal are:

1) Whether Ikegaya et al. (U.S. Pat. No. 5,263,129) in combination with various other references does not suggest all the limitations of claims 1-30, such that the Examiner has not made a prima facie case of obviousness; and

2) Whether there is no suggestion or motivation in the prior art to combine Chen (U.S. Pat. No. 5,822,506), Ikegaya (U.S. Pat. No. 5,263,129) and other various references in the manner asserted by the Examiner, such that the Examiner has not made a prima facie case of obviousness.

VII. GROUPING OF THE CLAIMS

The claims stand or fall together, other than the subject matter which has already been deemed allowable. Of the pending claims, Claim 1 is representative.

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VIII. ARGUMENTS

A. SUMMARY OF CLAIM REJECTIONS ASSERTED BY THE EXAMINER

Claims 1 –30 are presently pending. The Examiner rejected claims 1 and 5 under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Pat. No. 5,822,506) in view of Ikegaya et al. (U.S. Pat. No. 5,263,129) and Matysek et al. (U.S. Pat. No. 5,442,732). Claims 9, 13, 17, 21, 25, 29 and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Ikegaya. Claims 3, 4, 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Ikegaya et al., Matysek and Yamada (U.S. Pat. No. 5,798,738). Claims 11-12, 15-16, 19-20, 23-24 and 27-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. in view of Ikegaya and Yamada. Claims 10, 14, 18 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Ikegaya and Olarig (U.S. Pat. No. 5,878,237). Claim 2, 6 and 26 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claims and any intervening claims.

B. SUMMARY OF APPLICANT'S ARGUMENTS THAT THE EXAMINER'S REJECTIONS UNDER 35 U.S.C 103(a) ARE IMPROPER BECAUSE THE EXAMINER HAS FAILED TO MAKE A PRIMA FACE CASE OF OBVIOUSNESS

The 35 U.S.C. 103(a) rejections by the Examiner are improper, because the Examiner has failed to make a prima facie case of obviousness. Even if the references are combined as suggested by the Examiner, the cited references fail to render the

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claimed subject matter obvious because none of the references shows or suggests automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job. In addition, there is no suggestion whatsoever to combine Chen with Ikegaya and the other various references cited by the Examiner. Thus, the rejection of claims 1, 3-5, 7-25 and 27-30 is improper; and, the objection to claims 2, 6 and 26 is also improper.

C. THE EXAMINER HAS NOT MADE A PRIMA FACIE CASE OF OBVIOUSNESS BECAUSE THE COMBINATION OF CHEN, IKEGAYA AND OTHER VARIOUS REFERENCES ASSERTED BY THE EXAMINER FAILS TO TEACH OR SUGGEST ALL ELEMENTS OF ANY PENDING CLAIM

In order to make a prima facie case of obviousness, the combined references must teach or suggest all claim limitations. MPEP § 2143; *In re Royka,* 490 F.2d 981 (CCPA 1974). The references cited by the Examiner fail to teach or suggest all the limitations of any of the independent claims. Accordingly, they also fail to teach or suggest the limitations of any of the dependent claims. Therefore, the Examiner has failed to make a prima facie case of obviousness, and all pending claims 1-30 are allowable.

Applicant's independent claim 1 describes a method of performing setup operations on a finishing device. As claimed, the method includes "entering a print job into the printer, the print job including setup instructions for at least one finishing device written as an operator message" and "automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job." The setup operations on the instruction sheet are specific to that entered print job, and they can vary with the

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particular print job entered into the printer. Also, the setup instructions are for connected finishing devices and not the just printer itself. These elements in Applicant's independent claim 1, however, are not found in the references cited by the Examiner. Specifically, they are not found in the Ikegaya reference, which the Examiner relies on as teaching these elements.

In the 1st Office Action, which was mailed December 6, 2001, and is attached as Appendix B, the Examiner states that "Chen et al. do not teach printing an instruction sheet listing setup operations." (1st Office Action, pg. 3). In order to find this element, the Examiner alleges that "Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teach printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)." (1st Office Action, pg. 3)[1]. Contrary to the Examiner's assertion, Ikegaya does not show or suggest printing an instruction sheet listing setup operations for finishing devices to be performed prior to completing a particular print job.

Ikegaya et al. discloses an "apparatus for producing and utilizing sheets of manuals containing data corresponding to operating procedures for electronic devices." (Abstract). As described in Ikegaya, various different manual sheets can be used to simplify configuring a facsimile machine. (col. 1, lines 60-65). The manual sheets include frame and coordinate data corresponding to different functions, and the frame and coordinate data can be used in conjunction with an input device to program various

1 In Applicant's Office Action Response, which was mailed April 8, 2002 and is attached as Appendix C, Applicant first raised the argument that Ikegaya does not disclose teaching printing setup instructions for a finishing device. In the 2nd Office Action, which was mailed June 27, 2002 and is attached as Appendix D, the Examiner responded to this argument. (2nd Office

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functions of the facsimile machine. (col. 3, lines 9-37). For example, a manual sheet can be used to program a quick-dial feature, to create a list print out or to perform other various functions associated with the facsimile machine. (col. 5, lines 44-46; col. 5, lines 66-68; figs. 7-8) The manuals sheet are not used to program other devices, such as finishing devices, that are connected to the facsimile machine; and, Ikegaya does not even disclose any such devices attached to the facsimile machine.

In order to program the functions of the facsimile machine, a user selects the corresponding manual sheet. For example, if the user wants to program the quick-dial feature of the facsimile machine, the user would select the manual sheet corresponding to that feature. The user then places the manual sheet on a coordinate input unit. (col. 6, lines 20-24). Using an input device, such as a light pen, the user selects various regions of the manual sheet in order to program the facsimile machine for that function. (col. 6, lines 20-68; fig. 7)

For example, to program the quick-dial feature, the user would use the light pen to make a function selection corresponding to the quick-dial feature. (col. 6, lines 22-33; fig. 7). The function selection alerts the facsimile machine that the user is programming the quick-dial feature. (col. 6, lines 22-33; fig. 7). Next, the user uses the light pen to program in the telephone number for the quick-dial feature and to program an abbreviated quick-dial number corresponding to the telephone number. (col. 6, lines 48-60; fig. 7). The user might optionally program in other information needed to setup the

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Action, pg. 18). However, the Examiner's response consisted of nothing more than repeating these same two conculsory statements from the 1st Office Action.

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quick-dial feature. Once the user is done programming the quick-dial feature, the user can select another manual sheet to program a different feature.

The manual sheets described in Ikegaya can be created through a one-time process. (col. 8, lines 7-14). They are then generally available to the user, who can select from among the available manual sheets in order to program various functions of the facsimile machine. The manual sheets, however, are not printed by the facsimile machine in response to any particular input, such as a recently entered print job. (col. 8, lines 7-14). As they are not created in response to any particular input, such as a print job, they accordingly do not detail any particular setup instructions to be executed prior to completing that input. For example, an incoming fax, or other such input, to the fax machine would not responsively generate a manual sheet that details operations to be performed prior to processing the incoming fax.

Applicant, on the other hand, claims an instruction sheet that is printed in response to a particular input, such as a print job, and the instruction sheet lists instructions that are to be performed prior to completing the input. Specifically, claim 1 recites a "method of performing setup operations on a finishing device connected to an electrophotographic printer." The claim includes the steps of "entering a print job into the printer, the print job including setup instructions for at least one finishing device..." and, in response to entering the print job, "automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job."

As Ikegaya describes generally available manual sheets that are not created in response to any particular input, and which do not detail instructions to be performed prior to processing the input, Ikegaya does not even suggest the "automatically printing

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an instruction sheet listing setup operations to be performed prior to completing the print job" element of Applicant's independent claim 1. Even if Ikegaya did describe printing setup instructions for a pending job on the facsimile machine – which it does not in fact describe – it would still fail to show or suggest printing setup instructions for finishing devices attached to the facsimile machine that are used to complete the pending job on the facsimile machine.

Not only does Ikegaya not describe setup instructions for finishing devices, it doesn't even describe any finishing devices attached to the facsimile machine – much less finishing devices used in processing jobs on the facsimile machine. Ikegaya does not show or suggest "printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)," as the Examiner asserts, and therefore it does not satisfy the shortcomings of the other cited references.

Therefore, the Examiner has failed to make a prima facie case of obviousness with respect to independent claim 1, because all the elements of claim 1 are not found in the cited references. Accordingly, independent claim 1 and dependent claims 2-4 are all allowable. Independent claims 5, 9, 13, 17, 21 and 25 all include similar elements. For the reasons previously discussed with respect to claim 1, Ikegaya also fails to disclose all the elements of these claims. Therefore, independent claims 5, 9, 13, 17, 21 and 25 are all likewise allowable. Dependent claims 2-4, 6-8, 14-16, 18-20, 22-24 and 26-30, which depend from these independent claims, are also allowable.

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D. THE EXAMINER HAS NOT MADE A PRIMA FACIE CASE OF OBVIOUSNESS BECAUSE THE EXAMINER HAS NOT SHOWN ANY SUGGESTION OR MOTIVATION, EITHER IN THE CITED REFERENCES OR IN THE KNOWLEDGE GENERALLY AVAILABLE TO ONE OF ORDINARY SKILL IN THE ART, TO COMBINE CHEN, IKEGAYA AND OTHER VARIOUS REFERENCES IN THE MANNER ASSERTED BY THE EXAMINER

The Examiner bears the burden of establishing a prima facie case of obviousness. *In re Fritch,* 972 F.2d 1260, 1265 (Fed. Cir. 1992). As the Federal Circuit has explained, "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion support the combination. Under section 103, teaching of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hosp. Systems, Inc. v. Montefiore Hosp.,* 732 F.2d 1572, 1577 (Fed. Cir. 1984); see also *In re Lee,* 277 F.3d 1338 (Fed. Cir. 2002).

Accordingly, it is not enough that the references could be combined in the manner suggested by the Examiner -- the prior art must also suggest the desirability (and thus the obviousness) of the modification. *In re Gordon,* 733 F.2d 900, 902 (Fed. Cir. 1984) (emphasis added); see also Holdosh v. Block Drug Co., 786 F.Supp 1136, 1143 (Fed. Cir.1986); *In re Fritsch,* 972 F.2d at 1266 (explaining that the "mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification"). Thus, the Examiner can only meet the burden of establishing a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art [that] would lead that individual to

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combine the relevant teach of the references." *In re Fine,* 837 F.2d 1071, 1074 (Fed. Cir. 1988).

As the prior art must suggest the desirability of the combination, the proper view in making an obviousness determination is from a time just prior to the Applicant's conception of the invention. *In re Fine,* 837 F.2d at 1073. This is necessary, because "the references must be viewed without the benefit of hindsight vision afforded by the claimed invention." *Holdosh,* 786 F.2d at 1143. Using this reference point furhter prevents the impermissible use of the claimed invention as an instruction manual or template to piece together the teachings of the prior art in order to render the invention obvious. *In re Fritsch,* 972 F.2d at 1266.

In this case, the Examiner has failed to show any suggestion or motivation, either in the references or in the knowledge available to one of ordinary skill in the art at the time the invention was made, to combine the references in the manner asserted by the Examiner. In providing his rationale for combining Chen and Ikegaya, the Examiner asserts that:

> It would have been obvious to a person having ordinary still in the art at the time the invention was made to have modified Chen's printing system by the teachings of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various function very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

(2nd Office Action, pg. 17).

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Rather than specifically stating any reasons for combining references, the Examiner simply listed the advantages that would result after the cited references were combined. For example, the Examiner stated that a printer instruction sheet for a remote device (which the Examiner claims would result from combining Chen and Ikegaya) is easy to carry and would thus be better than trying to remember instructions viewed on a remote monitor. This advantage is not disclosed in any of the cited references, but is taught in the Applicant's disclosure itself: "By carrying the printed instruction sheet to the finished device 42, the operator is able to refer to the instruction sheet while performing the necessary setup operations at the remote finishing device 42, obviating the need for the operator to remember the instructions and enabling the operator to re-check the settings without walking back to the printer user interface 22." (Application at page 8, lines 19-23). Using an advantage only found in the Applicant's disclosure against the Applicant is impermissible hindsight, and it cannot serve as a motivation to combine references. *Hodosh,* 786 F.2d at 1143.

In Ikegaya there is no need to carry an instruction sheet, because Ikegaya discloses using manual sheets to configure a single device – a facsimile machine. In fact, Ikegaya doesn't even disclose any other devices connected to a facsimile machine. As previously discussed, the manual sheets in Ikegaya are used to perform routine setup functions for the facsimile machine. They are not printed in response to any pending job, such as an incoming fax, and they do not include setup instructions to be performed prior to completing the pending job. Thus, there is no motivation to modify the manual sheets of Ikegaya to include setup instructions for other devices, and there is no reason to

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combine Ikegaya with Chen (or another similar reference) that shows finishing devices connected to a printer.

Similarly, Chen lacks any suggestion that would lead one to consult Ikegaya. In Chen there is no need to carry a printed instruction sheet in Chen, because Chen uses "post processor control data to direct modifications to be made to said printer sheet," that is, under the control of a processor and without operator setup. (Col 7, lines 27-35). Chen shows a method of configuring finishing devices via an electrical connection between the printer and the finishing devices, and thus Chen actually teaches away from manually carrying information between the printer and its finishing devices. Further, a facsimile machine is not a finishing device for a printer, and therefore one consulting the Chen reference dealing with commercial printing systems would not be motivated to even refer to the Ikegaya reference that discusses a single facsimile machine.

For these reasons there is no motivation to combine Chen and Ikegaya. Neither reference includes any suggestion that would lead one to consult the other. Therefore, the combination is improper and the Examiner cannot make a prima facie case of obviousness with respect to independent claim 1. Accordingly, independent claim 1 and dependent claims 2-4 are all allowable. The rejections of independent claims 5, 9, 13, 17, 21 and 25 based on the combination of Chen and Ikegaya are also improper. Therefore, independent claims 5, 9, 13, 17, 21 and 25 are all allowable. Dependent claims 2-4, 6-8, 14-16, 18-20, 22-24 and 26-30, which depend from these independent claims, are also allowable.

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IX. SUMMARY

On the basis of the foregoing and in view of the arguments presented herein, reversal of each and every rejection is appropriate.

Respectfully submitted,

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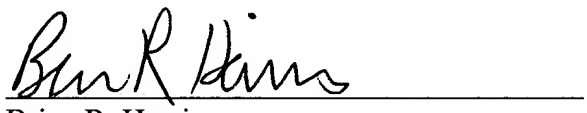
Date: December 18, 2002

By: 

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Appendix A – Pending Claims

1. A method of performing setup operations on a finishing device connected to an electrophotographic printer, the printer having a printer user interface, comprising the steps of:

a) entering a print job into the printer, the print job including setup instructions for at least one finishing device written as an operator message;

b) automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job;

c) automatically placing all pending print jobs on hold;

d) performing the setup operations listed on the printed instruction sheet; and

e) entering a release code to thereby release the print job from hold and allow the printer to complete the print job.

2. The method of claim 1, further comprising the steps of:
   a. accessing a database of setup instructions that are to be performed on the at least one finishing device;
   b. retrieving a file from the database containing instructions for a specified finishing device;
   c. reading the file; and
   d. translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet.

3. The method of claim 1 wherein the print job is entered through a network.

4. The method of claim 1 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

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5. A method of performing setup operations on a finishing device connected to an electrophotographic printer, the printer having a printer user interface, comprising the steps of:

a) entering a print job into the printer, the print job including setup instructions for at least one finishing device written as an operator message;

b) automatically printing an instruction sheet listing setup operations to be performed prior to completing the print job;

c) automatically placing on hold all pending print jobs that specify the finishing device;

d) performing the setup operations listed on the printed instruction sheet; and

e) entering a release code to thereby release the print job from hold and allow the printer to complete the print job.

6. The method of claim 5, further comprising the steps of:
   a. accessing a database of setup instructions that are to be performed on the at least one finishing device;
   b. retrieving a file from the database containing instructions for a specified finishing device;
   c. reading the file; and
   d. translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet.

7. The method of claim 5 wherein the print job is entered through a network.

8. The method of claim 5 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

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9. A method of managing a printer system, comprising the steps of:
    a. receiving a print job;
    b. determining whether the print job specifies a finishing device and whether the print job includes instructions directing an operator to perform specific setup operations and, if so, placing all print jobs on hold;
    c. printing an instruction sheet listing a series of setup operations to be performed by the operator;
    d. performing the setup operations listed on the printed instruction sheet; and
    e. entering a code that removes the hold, allowing the print job to proceed.

10. The method of claim 9, wherein at least some of the instructions for setup operations are stored on a local disk.

11. The method of claim 9 wherein the print job is received from a network.

12. The method of claim 9 herein the printer is a stand-alone unit including a scanner that provides image data to the printer.

13. A method of managing a printer system, comprising the steps of:
    a. receiving a print job;
    b. determining whether the print job specifies a finishing device and whether the print job includes instructions directing an operator to perform specific setup operations and, if so, placing on hold all print jobs that specify the finishing device;
    c. printing an instruction sheet listing a series of setup operations to be performed by the operator;
    d. performing the setup operations listed on the printed instruction sheet; and
    e. entering a code that removes the hold, allowing the print jobs to proceed.

14. The method of claim 13 wherein at least some of the instructions for setup operations are stored on a local disk.

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15. The method of claim 13 wherein the print job is received from a network.

16. The method of claim 13 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

17. A method of managing a printer system, comprising the steps of:
    a. setting up a print job using a setup menu that includes an instruction field in which operator setup instructions may be entered;
    b. submitting the print job to the printer;
    c. determining whether any text has been entered in the instruction field and, if so, placing all print jobs on hold;
    d. printing an instruction sheet comprising the text entered in the operator instruction field;
    e. performing one or more setup operations listed on the printed instruction sheet; and
    f. entering a code that removes the hold, allowing the print jobs to proceed.

18. The method of claim 17, wherein at least some of the instructions for setup operations are stored on a local disk.

19. The method of claim 17 wherein the print job is setup on a network.

20. The method of claim 17 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

21. A method of managing a printer system, comprising the steps of:
    a. receiving a print job;
    b. determining that the print job includes operator instructions ;
    c. automatically placing the print job on hold while allowing other print jobs to continue;

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d. printing an instruction sheet corresponding to the operator instructions;

e. reviewing the printed instruction sheet and performing operations specified by the operator instructions; and

f. entering a code that removes the hold, allowing the print job to proceed.

22. The method of claim 21, wherein at least some of the operator instructions are stored on a local disk.

23. The method of claim 21 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

24. The method of claim 21 wherein the print job is setup on a network.

25. A method of coordinating a printer and an associated finishing device that is connected to the printer, comprising the steps of:

a) receiving, at the printer, a first print job, the first print job including received setup instructions for at least one finishing device that is associated with the first print job;

b) printing an instruction sheet in response to receiving the received setup instructions, the instruction sheet listing setup operations associated with the first print job, the setup operations to be performed on the at least one finishing device prior to completing the first print job;

c) placing at least the first print job on hold; and

d) receiving a release code to release the print job from hold and allow the printer to complete the first print job.

26. The method of claim 25, further comprising the steps of:

accessing a database of internal setup instructions that are to be performed on the at least one finishing device, the internal setup instructions being associated with the received setup instructions;

retrieving a file from the database containing instructions for the at least one finishing device; and

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translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet.

27. The method of claim 25 wherein the print job is received via a network.

28. The method of claim 25 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

29. The method of claim 25 wherein placing at least the first print job on hold comprises placing all print jobs on hold.

30. The method of claim 25 wherein placing at least the first print job on hold comprises placing on hold any print jobs that require using the at least one finishing device that is associated with the first print job.

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09/692,645	10/19/2000	Edward M. Housel	MBHB00-591	8278

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DEC 18 2002
PATENT & TRADEMARK OFFICE

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EXAMINER
POON, KING Y

ART UNIT	PAPER NUMBER
2624	4

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.	Applicant(s)
09/692,645	Edward M. Housel
Examiner	**Art Unit**
King Y. Poon	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-24* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-24* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

DOV POPOVICI
PRIMARY EXAMINER

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

OIPE JC48 DEC 18 2002 PATENT & TRADEMARK OFFICE

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. (U.S. Patent # 5,442,732)

Regarding claims 1, and 5: Chen et al. teach a method of performing setup operations (column 3, lines 1-10, column 4, line 29) on a finishing device (20, 22, column 3, lines 1-10, fig. 1) connected to an electrophotographic printer, (10, fig. 1) the printer comprising the steps of: a) entering a print job (column 3, lines 17-40) into the printer, the print job including setup instructions (fig. 2, column 2, lines 38-41, column 4, lines 8-35) for at least one finishing device (20, 22, fig. 1) written as an operator message; (column 4, lines 4-25) b) automatically supplying setup operations to be performed prior to completing the print job; (column 4, lines 10-20) c) automatically placing all pending print jobs on hold that specify the finishing device; (column 4, lines 20-25, 29, fig. 2); d) performing the setup operations according to supplied instruction; (column 4, lines 29-32); and e) entering a release code (the program code that control the

branching from 44 to 42, fig. 2) to thereby release the print job from hold and allow the printer to complete the print job (column 3, lines 23-25)

Chen et al. do not teach printing an instruction sheet listing setup operations.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by: printing an instruction sheet listing setup operations.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Chen et al. as modified by Ikegaya still do not teach a printer user interface.

Matysek teaches a printer (8, fig. 1) having a printer user interface (62, 52, 64, and 66, fig. 1).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. as modified by Ikegaya by: providing the printer with a printer user interface.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. as modified by Ikegaya by the teaching of Matysek because of the following reasons: (a) it would have allowed users to control the printer at the location of the printer; and (b) it would have allowed users to set up job parameters such as the quatity of prints, and finishing selections, as taught by Matysek at column 1, lines 10-25.

3. Claims 9, 13, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129)

Regarding claims 9 and 13: Chen et al. teach a method of managing a printer system, (fig. 1) comprising the steps of: a. receiving a print job; (29, fig. 2); b. determining whether the print job specifies a finishing device (20, 22, column 3, lines 5-15) and whether the print job includes instructions directing an operator (column 4, lines 8-35, 40, fig. 2) to perform specific setup operations and, if so, placing on hold all print jobs that specify the finishing device; (column 4, lines 20-25, 29 of fig. 2); c. performing the setup operations sheet; (column 4, lines 29-32) and d. entering a code that removes the hold, allowing the print jobs to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet listing setup operations to be performed by the operator.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by: printing an instruction sheet listing setup operations to be performed by the operator.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 17: Chen et al. teach a method of managing a printer system, fig. 1) comprising the steps of: a. setting up a print job (fig. 2) using a setup menu that includes an instruction field in which operator setup instructions may be entered; (column 4, lines 10-20) b. submitting the print job to the printer; (28, fig. 2) c. determining whether any text (setup instruction, column 4, line 10-24) has been entered in the instruction field and, (column 4, lines

25-32) if so, placing all print jobs on hold; (print job is hold on 29, fig. 2, before post processor is being set up in 44, fig. 2) d. performing one or more setup operations; (44, fig. 2) and e. entering a code that removes the hold, allowing the print jobs to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet comprising the text (setup instruction) entered in the operator instruction field.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by: printing an instruction sheet comprising the text (setup instruction) entered in the operator instruction field.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 21. Chen et al teach a method of managing a printer system, (fig. 2) comprising the steps of: a. receiving a print job; (29, fig. 2) b. determining that the print job includes operator instructions; (40, fig. 2) c. automatically placing the print job on hold (print job is not passing 44 before post processor is being set up) while allowing other print jobs to continue; (other job is stored in 29, fig. 2) d. performing operations specified by the operator instructions; (44, fig. 2) and e. entering a code that removes the hold, allowing the print job to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet corresponding to the operator instructions.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by: printing an instruction sheet corresponding to the operator instructions;

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by

Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

4. Claims 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. as applied to claims 1, 5, above, and further in view of Yamada (U.S. Patent # 5,798,738).

Regarding claims 3, and 7: Chen et al. in view of Ikegaya et al. and Matysek do not teach wherein the print job is entered through a network.

Yamada teaches to enter print jobs (column 5, lines 60-61, column 14, line 2) to a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. and Matysek by entering the print job through a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. and Matysek by the teaching of Yamada because of the following reasons (a) it would have allowed users to sent print jobs to remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to send print jobs to different printers; and (c) it would have allowed users to print the print jobs with other printers while a printer is down in the network.

Regarding claims 4, and 8: Chen et al. in view of Ikegaya et al. and Matysek do not teach wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

Yamada teaches a printer which is a stand-alone unit including a scanner that provides image data to the printer (fig. 13 A, column 4, lines 15-25, column 5, line 6).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. and Matysek by replacing the printer with a printer which is a stand-alone unit including a scanner that provides image data to the printer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. and Matysek by the teaching of Yamada because of the following reasons (a) it would have allowed the printer to scan images for uses; (b) adding scanning functions to the printer would have provided addition functions to be used by users and thereby, increase the usability of the printing system.

5. Claims 11, 12, 15, 16, 19, 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) as applied to claims 9, 13, 17, and 21 above, and further in view of Yamada (U.S. Patent # 5,798,738).

Regarding claims 12, 16, 20, and 23: Chen et al. in view of Ikegaya et al. do not teach wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

Yamada teaches a printer which is a stand-alone unit including a scanner that provides image data to the printer (fig. 13 A, column 4, lines 15-25, column 5, line 6).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. by replacing the printer with a printer which is a stand-alone unit including a scanner that provides image data to the printer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed the printer to scan images for uses; (b) adding scanning functions to the printer would have provided addition functions to be used by users and thereby, increase the usability of the printing system.

Regarding claims 11, and 15: Chen et al. in view of Ikegaya et al. do not teach wherein the print job is received from a network.

Yamada teaches to receive print jobs (column 5, lines 60-61, column 14, line 2) by a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. by receiving the print job through a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed users to print print jobs using remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to print print jobs to different printers; and (c) it would have allowed users to print print jobs with other printers while a printer is down in the network.

Regarding claims 19 and 24: Chen et al. in view of Ikegaya et al. do not teach wherein the print job is set up on a network.

Yamada teaches to set up print jobs (column 5, lines 60-61, column 14, line 2) to be printed by a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. by setting up the print job on a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed users to print print jobs

using remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to print print jobs to different printers; and (c) it would have allowed users to print print jobs with other printers while a printer is down in the network.

6. Claims 10, 14, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) as applied to claims 9, 13, 17, and 21 above, and further in view of Olarig (U.S. Patent # 5,878,237).

Regarding claims 10, 14, 18, and 22: Chen et al. do not teach wherein at least some of the instructions for setup operations are stored on a memory.

Ikegaya teaches to store the setup instructions in a memory (column 3, lines 1-10)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by: storing the setup instructions in a memory

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al. by the teaching of Ikegaya because of the following reasons: (a) storing the setup instruction by a memory would have prevented the setup instruction being lost, and users would save time for not having to write the setup instruction every time the system is to be setup.

Chen et al as modified by Ikegaya still do not teach storing the instructions in a local disk.

Olarig teaches to use a local disk as a memory for storing information (column 15, lines 15-20).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al as modified by Ikegaya by: replacing the memory used to store the setup instruction by a local disk.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al as modified by Ikegaya by the teaching of Olarig because of the following reasons: (a) a hard disk would have allowed the printer system to save data from losing even when the power to the system is being turned off; and (b) a hard disk is more durable compared to a tape of a floppy disk, and thereby, allowing the system to last longer.

7. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. as applied to claims 1, and 5 above, and further in view of Campbell, Jr. et al. (U.S. Patent 5,172,326) and Ng (U.S. Patent # 5,455,681).

Regarding claims 2 and 6: Chen et al in view of Ikegaya et al. and Matysek teach to create instruction for a specified finishing device (44, fig. 2).

Chen et al in view of Ikegaya et al. and Matysek do not teach: a. accessing a database of setup instructions that are to be performed on the at least one finishing device; b. retrieving a file from the database containing instructions for a specified finishing device; and c. reading the file.

Campbell, Jr. et al., teach accessing a database (37, fig. 5) of instructions; (36, fig. 5); b. retrieving a file (column 17, lines 25-30) from the database containing instructions; and c. reading the file (column 17, lines 25-30).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al in view of Ikegaya et al. and Matysek by: a. accessing a database of setup instructions that are to be performed on the at least one finishing device; b. retrieving a file from the database containing instructions for a specified finishing device; and c. reading the file.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al in view of Ikegaya et al. and Matysek by the teaching of Campbell, Jr. et al. because of the following reasons: (a) a data base would have provided a bigger memory for storing the setup instructions, and (b) storing the setup instruction by a data base would have prevented the setup instruction being lost, and users would save time for not having to write the setup instruction every time the system is to be setup.

Chen et al in view of Ikegaya et al. and Matysek as modified by Campbell, Jr. et al. do not teach translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet.

Ng translating a file (fig. 1, text file, column 2, lines 40-50) into a page description file (Postscript file, fig. 1) that is rasterized to be printed (column 5, lines 30-45).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al in view of Ikegaya et al. and Matysek as modified by Campbell, Jr. et al. by: translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen et al in view of Ikegaya et al. and Matysek as modified by Campbell, Jr. et al. by the teaching of Ng because of the following reasons: (a) page description file would contain less data to be transmitted compare to bitmap file and would have conserve network bandwidth when transmitting page description file instead of bitmap file; and (b) it would have speed up data transmitting because page description file has less data compare to bitmap file; (c) Page description file is a compressed file and would require less memory to store the file in the printer, thereby, reducing memory requirments of the printer.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

December 3, 2001

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(MBHB Case No. 00-591)

In the Application of:	)	
	)	
Edward M. Housel	)	Group Art Unit: 2624
	)	
Serial No.: 09/692,645	)	Examiner: King Y. Poon
	)	
Filed: October 19, 2000	)	Confirmation No.: 8278
	)	
For: METHOD OF GENERATING PRINTER SETUP INSTRUCTIONS	)	

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO OFFICIAL ACTION

Dear Sir:

In response to the Official Action dated December 6, 2001, applicant submits the following amendments and remarks.

AMENDMENTS

In the Drawings:

Please approve the correction to Figure 1 as shown in the attached amended drawing.

In the Specification:

Please replace the paragraph beginning at page 5, line 24 with the following paragraph:

The marking engine 40 also includes output devices that transfer the printed out pages to one or more finishing devices 42 connected to the printer 20 by a simple electrical connection 12. The finishing device 42 includes a finishing device user interface 33. The finishing device 42 may be any commonly used finishing device, such as a hole punch or binder.

Please replace the paragraph beginning at page 5, line 29 with the following paragraph:

The printer 20 includes a logic control unit 50, including a printer user interface 22, through which the operator inputs functions and receives messages from the printer 20. The

printer 20 also includes a database 60 of shared instructions, stored on a local disk, accessed by the RIP. The instructions stored in the database include, for example, setup instructions for a particular finishing device that are to be followed by the operator in all cases, regardless of the particular configuration chosen. Generally, these instructions will include directions as to how to physically set up a given finishing device. For example, a hole punch may have detents that must be physically moved to a desired position, but are secured by spring-loaded pins that must be removed prior to moving the detents. Likewise, the shared instructions may remind the operator to power down a particular finishing device prior to performing setup operations thereon, should that step be necessary.

In the Claims:

Please add the following new claims:

25. (New) A method of coordinating a printer and an associated finishing device that is connected to the printer, comprising the steps of:

a) receiving, at the printer, a first print job, the first print job including received setup instructions for at least one finishing device that is associated with the first print job;

b) printing an instruction sheet in response to receiving the received setup instructions, the instruction sheet listing setup operations associated with the first print job, the setup operations to be performed on the at least one finishing device prior to completing the first print job;

c) placing at least the first print job on hold; and

d) receiving a release code to release the print job from hold and allow the printer to complete the first print job.

26. (New) The method of claim 25, further comprising the steps of:

accessing a database of internal setup instructions that are to be performed on the at least one finishing device, the internal setup instructions being associated with the received setup instructions;

retrieving a file from the database containing instructions for the at least one finishing device; and

translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet.

27. (New) The method of claim 25 wherein the print job is received via a network.

28. (New) The method of claim 25 wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

29. (New) The method of claim 25 wherein placing at least the first print job on hold comprises placing all print jobs on hold.

30. (New) The method of claim 25 wherein placing at least the first print job on hold comprises placing on hold any print jobs that require using the at least one finishing device that is associated with the first print job.

REMARKS

In the Official Action dated December 26, 2001, the Examiner rejected pending claims 1-24 as being obvious in light of Chen et. al., U.S. Patent No. 5,822,506 together with various combinations of Ikegaya et. al., U.S. Patent No. 5,263,129, Matysek et. al., U.S. Patent No. 5,442,732, Yamada, U.S. Patent No. 5,798,738, Olarig, U.S. Patent No. 5,878,237, Campbell, Jr. et. al., U.S. Patent No. 5,172,326, and/or Ng, U.S. Patent No. 5,455,681.

Applicant has made several amendments to the specification and drawings to correct minor errors. Applicant respectfully submits that no new matter has been added by these amendments. Support may be found throughout the specification.

Applicant intends to make no admissions by the following remarks, but rather hopes to clarify the present invention in an effort to promote allowance of the pending claims.

For the reasons set forth below, applicant traverses the rejections and requests reconsideration.

Response to Rejections under 35 U.S.C. § 103(a)

Claims 1 and 5:

The Examiner rejected claims 1 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Matysek.

According to MPEP § 2142, in order to establish a *prima facie* case of obviousness, there must be 1) some suggestion or motivation to modify a reference or to combine teachings from multiple references, 2) a reasonable expectation of success; and 3) the references so combined must teach or suggest all the claim limitations.

A. The Examiner Has Shown No Motivation Or Suggestion To Combine The Cited References.

Rather than specifically state any reasons for combining references, the Examiner simply listed the advantages that would result after the cited references were combined. For example, the Examiner stated that a printed instruction sheet for a remote device (which the Examiner claims would result from combining Chen and Ikegaya) is easy to carry and would thus be better than trying to remember instructions viewed on a remote monitor. This advantage is not disclosed in any of the cited references, but is taught in applicant's disclosure itself: "By carrying the printed instruction sheet to the finishing device 42, the operator is able to refer to the instruction sheet while performing the necessary setup operations at the remote finishing device 42, obviating the need for the operator to remember the instructions and enabling the operator to re-check the settings without walking back to the printer user interface 22." (Application at page 8, lines 19-23).

There is no need to carry an instruction sheet in Ikegaya, because Ikegaya discloses printing an instruction sheet for the very device that printed it, a fax machine. Similarly, there is no need to carry a printed instruction sheet in Chen, because Chen uses "post processor control data to direct modifications to be made to said printed sheet," that is, under the control of a processor and without operator setup. (Col. 7, lines 27-35). Using an advantage only found in applicant's invention against applicant is impermissible hindsight, and cannot serve as a motivation to combine references.

Moreover, the Examiner relies on Chen as the basis for all the limitations in claims 1 and 5 except: 1) printing an instruction sheet and 2) a printer having a printer user interface. According to MPEP § 2143.01, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the

teachings of the references are not sufficient to render the claims *prima facie* obvious." (Citing *In re Ratti,* 270 F.2d 810 (CCPA 1959)). If Chen, however, were modified as suggested by the Examiner, the principle of operation of Chen would have to be changed; Chen discloses a method that includes "sending said separated post processor control data from the printer to the intelligent post processor; receiving the post processor control data at the intelligent post printer processor; and modifying at least one of the printed sheets in the print job at the intelligent post printer processor, using the post processor control data to direct modifications to be made to said printed sheet." (Col. 7, lines 27-35). Thus, to remove (and print) setup data at the printer before it reaches a finishing device, as claimed in applicant's invention, Chen's principle of operation would have to be modified to 1) eliminate the step of sending control data from the printer to the intelligent post processor, and to 2) eliminate the step of receiving the control data at the post processor. Therefore, the disclosures of Chen and Ikegaya are not sufficient to render claims 1 and 5 *prima facie* obvious.

In addition, Ikegaya discloses an apparatus that prints an instruction sheet that is necessarily placed on a "coordinates input screen" of the same device to which the instructions relate. (Col 8, lines12-13). There would thus be no motivation to combine Ikegaya with another reference to print an instruction sheet that includes instructions for a finishing device that is not the same device that printed the instructions, as applicant has claimed.

B. The Combined References Do Not Yield The Claimed Invention.

Combining Chen and Ikegaya and Matysek does not yield the applicant's invention. Ikegaya does not disclose or suggest an apparatus that receives setup instructions for a finishing device, the instructions included as part of a print job. Ikegaya only discloses an apparatus that

prints a page from an instruction manual for the same device that prints the page, while Chen, as the Examiner noted, does "not teach printing an instruction sheet listing setup operations," and in fact teaches away from a printed instruction sheet, as discussed above. Matysek is only cited as disclosing a printer with a printer user interface, and does not include any of the above-discussed limitations. Because neither Ikegaya nor Chen nor Matysek show or suggest a method that includes printing setup instructions for a finishing device, and because there is no motivation to combine Ikegaya and Chen, applicant requests notice of allowance of claims 1 and 5. Claims 2-4 and 6-8 depend ultimately from claims 1 and 5. Allowance of claims 2-4 and 6-8 will therefore follow directly from claims 1 and 5.

Claims 9, 13, 17, and 21:

The Examiner rejected claims 9, 13, 17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya. As discussed in detail above, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed. Therefore, applicant believes claims 9, 13, 17, and 21 to be in condition for allowance, and requests notice to that effect. Claims 10-12, 14-16, 18-20, and 22-24 depend ultimately from claims 9, 13, 17, and 21. Allowance of claims 10-12, 14-16, 18-20, and 22-24 will therefore follow directly from allowance of claims 9, 13, 17, and 21.

Claims 3, 4, 7, and 8:

The Examiner rejected claims 3, 4, 7, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Matysek as applied to claims 1 and 5 above, and

further in view of Yamada. As discussed in detail above with reference to claims 1 and 5, from which claims 3, 4, 7, and 8 depend, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed. The Examiner cited Yamada for disclosing a print job entered through a network. Yamada, however, adds nothing new to the lack of motivation or disclosure of all the claimed limitations as already discussed; thus the combination of Chen, Ikegaya, and Matysek fails to render claims 3, 4, 7, and 8 obvious. Notice of allowance of claims 3, 4, 7, and 8 is therefore requested.

Claims 11, 12, 15, 16, 19, 20, 23, and 24:

The Examiner rejected claims 11, 12, 15, 16, 19, 20, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Yamada. As discussed in detail above, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed. Therefore, because the base claims from which claims 11, 12, 15, 16, 19, 20, 23, and 24 ultimately depend are allowable, claims 11, 12, 15, 16, 19, 20, 23, and 24 are allowable.

Additionally, in rejecting claims 12, 16, 20, and 23, the Examiner cited Yamada for disclosing a "printer which is a stand-alone unit including a scanner that provides image data to the printer." In this regard, Yamada adds nothing new to the lack of motivation or disclosure of all the claimed limitations as already discussed with reference to the base claims 9, 13, 17, and 21 from which they depend; thus the combination of Chen, Ikegaya, and Matysek fails to render claims 12, 16, 20, and 23, obvious.

Furthermore, the Examiner has not articulated a motivation to combine Chen and Ikegaya with Yamada, other than to list advantages that could be realized after the combination is made, which is merely using impermissible hindsight.

Claims 11 and 15 are allowable because they depend from allowable base claims, as discussed above. Claims 11 and 15 are also independently allowable because in rejecting claims 11 and 15, the Examiner cited Yamada for disclosing "print jobs [received] through a network." Yamada, however, does not remedy the lack of motivation or disclosure of all the claimed limitations as already discussed, nor is any motivation for combining Chen and Ikegaya with Yamada articulated; thus the combination of Chen, Ikegaya, and Yamada fails to render claims 11 and 15 obvious.

In rejecting claims 19 and 24, the Examiner cited Yamada for disclosing print jobs set up through a network. Claims 19 and 24 are allowable because they depend from allowable base claims, as discussed above, and because Yamada adds nothing to the lack of motivation or disclosure of all the claimed limitations as already discussed with reference to base claims 17 and 21, from which claims 19 and 24 depend. Further, there is no motivation to combine Yamada with either Chen or Ikegaya because Yamada has no need for instruction sheets and does not disclose or suggest a discrete finishing device as claimed; thus the combination of Chen, Ikegaya, and Yamada fails to render claims 19 and 24 obvious.

Notice of allowance of claims 11, 12, 15, 16, 19, 20, 23, and 24 is therefore requested.

Claims 10, 14, 18, and 22:

The Examiner rejected claims 10, 14, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Olarig. As discussed in detail above, there is no

motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed, also discussed above. Therefore, because the base claims from which claims 10, 14, 18, and 22 ultimately depend are allowable, claims 10, 14, 18, and 22 are allowable.

Claims 2 and 6:

The Examiner rejected claims 2 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Matysek as applied to claims 1 and 5, and in further view of Campbell and Ng. As discussed in detail above, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed, also discussed above. Thus, a *prima facie* case of obviousness regarding claims 1 and 5 has not been established by the combination of Chen and Ikegaya. Because claims 2 and 6 depend ultimately from claims 1 and 5, allowance of claims 2 and 6 will follow directly from the allowance of claims 1 and 5.

As further discussed above, Matysek does not cure the deficiency of Chen and Ikegaya with regard to rendering claims 1 and 5 or claims 2 and 6 obvious. Therefore, because the base claims (1 and 5) from which claims 2 and 6 ultimately depend are allowable, claims 2 and 6 are allowable.

In rejecting claims 2 and 6, the Examiner stated that Chen in view of Ikegaya and Matysek do not teach: "a. accessing a database of setup instructions that are to be performed on the at least one finishing device; b. retrieving a file from the database containing instructions for a specified finishing device; and c. reading the file." The Examiner further stated that Campbell discloses all of the above elements, and that it would have been obvious to combine Campbell with Chen, Ikegaya and Matysek.

To make out a *prima facie* case of obviousness as required by 35 U.S.C. § 103(a), each cited reference must be in an art analogous to the art of the invention. At the outset, it should be noted that Campbell does not apply to applicant's field of endeavor. In particular, Campbell shows a "method and system for cutting a web, such as a patterned fabric." (Abstract). This is not an analogous field to that of the invention, which relates to printing methods and systems. Further, there is no motivation to combine Campbell with any of the other references cited in the Office Action. Rather, the Examiner has simply recited the advantages that would result if the references were combined to arrive at applicant's invention, assuming *arguendo* that the cited combination would yield the claimed invention (which applicant does not admit). Since Campbell does not have a finishing device or even a printer associated with a finishing device, it is unfathomable that one of ordinary skill in the art would find any motivation or suggestion there to combine Campbell with Chen, Ikegaya and Matysek to print an instruction sheet for a finishing device. Therefore, combining Campbell with Chen, Ikegaya and Matysek requires resort to impermissible hindsight.

Next, the Examiner observes that neither Campbell, Chen, Ikegaya, nor Matysek teaches a page description file that is rasterized and incorporated into a printed instruction sheet, and then states that Ng discloses those elements. As with Campbell, Ng does not disclose a printer with an associated printing device, nor does anything in Ng show or suggest a need for an instruction sheet, printed or otherwise, directed as it is to "transform[ing] a high resolution binary data file to a lower resolution grey level file for printing by a lower resolution printer." (Abstract). Thus, Ng is not analogous art, and even if it is found to be analogous, there is no motivation or suggestion to combine Ng with the other references cited to arrive at the claimed invention. The Examiner's recitation of advantages that could be realized by the incongruous

combination of Campbell, Chen, Ikegaya, Matysek, and Ng is hindsight, not motivation or suggestion to combine. Because claims 2 and 6 depend from allowable claims 1 and 5, and for the independent reasons stated above, applicant believes claims 2 and 6 to be in condition for allowance, and requests notice to that effect.

CONCLUSION

Applicant submits that the present application is now in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, he is invited to telephone the undersigned at any time.

Respectfully submitted,

Date: April 8, 2002

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Paragraph beginning at page 5, line 24:

The marking engine **40** also includes output devices that transfer the printed out pages to one or more finishing devices **42** connected to the printer **20** by a simple electrical connection **12**. The finishing device **42** includes a finishing device user interface [**43**]**33**. The finishing device **42** may be any commonly used finishing device, such as a hole punch or binder.

Paragraph beginning at page 5, line 29

The printer **20** includes a logic control [center]unit **50**, including a printer user interface **22**, through which the operator inputs functions and receives messages from the printer **20**. The printer **20** also includes a database **60** of shared instructions, stored on a local disk, accessed by the RIP. The instructions stored in the database include, for example, setup instructions for a particular finishing device that are to be followed by the operator in all cases, regardless of the particular configuration chosen. Generally, these instructions will include directions as to how to physically set up a given finishing device. For example, a hole punch may have detents that must be physically moved to a desired position, but are secured by spring-loaded pins that must be removed prior to moving the detents. Likewise, the shared instructions may remind the operator to power down a particular finishing device prior to performing setup operations thereon, should that step be necessary.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,645	10/19/2000	Edward M. Housel	MBHB00-591	8278

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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/692,645	Applicant(s) HOUSEL, EDWARD M.	
	Examiner King Y. Poon	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-5,7-25 and 27-30* is/are rejected.

7)☒ Claim(s) *2, 6, 26* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

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Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

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DETAILED ACTION

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. (U.S. Patent # 5,442,732)

Regarding claims 1, and 5: Chen et al. teach a method of performing setup operations (column 3, lines 1-10, column 4, line 29) on a finishing device (20, 22, column 3, lines 1-10, fig. 1) connected to an electrophotographic printer, (10, fig. 1) the printer comprising the steps of: a) entering a print job (column 3, lines 17-40) into the printer, the print job including setup instructions (fig. 2, column 2, lines 38-41, column 4, lines 8-35) for at least one finishing device (20, 22, fig. 1) written as an operator message; (column 4, lines 4-25) b) automatically supplying setup operations to be performed prior to completing the print job; (column 4, lines 10-20) c) automatically placing all pending print jobs on hold that specify the finishing device; (column 4, lines 20-25, 29, fig. 2); d) performing the setup operations according to supplied instruction; (column 4, lines 29-32); and e) entering a release code (the program code that control the

branching from 44 to 42, fig. 2) to thereby release the print job from hold and allow the printer to complete the print job (column 3, lines 23-25)

Chen et al. do not teach printing an instruction sheet listing setup operations.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Chen et al. as modified by Ikegaya still do not teach a printer user interface.

Matysek teaches a printer (8, fig. 1) having a printer user interface (62, 52, 64, and 66, fig. 1).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system as modified by Ikegaya by: providing the printer with a printer user interface.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system as modified by Ikegaya by the teaching of Matysek because of the following reasons: (a) it would have allowed users to control the printer at the location of the printer; and (b) it would have allowed users to set up job parameters such as the quatity of prints, and finishing selections, as taught by Matysek at column 1, lines 10-25.

3. Claims 9, 13, 17, 21, 25, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129)

Regarding claims 9 and 13: Chen et al. teach a method of managing a printer system, (fig. 1) comprising the steps of: a. receiving a print job; (29, fig. 2); b. determining whether the print job specifies a finishing device (20, 22, column 3, lines 5-15) and whether the print job includes instructions directing an operator (column 4, lines 8-35, 40, fig. 2) to perform specific setup operations and, if so, placing on hold all print jobs that specify the finishing device; (column 4, lines 20-25, 29 of fig. 2); c. performing the setup operations sheet; (column 4, lines 29-32) and d.

entering a code that removes the hold, allowing the print jobs to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet listing setup operations to be performed by the operator.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations to be performed by the operator.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 17: Chen et al. teach a method of managing a printer system, (fig. 1) comprising the steps of: a. setting up a print job (fig. 2) using a setup menu that includes an instruction field in which operator setup instructions may be entered; (column 4, lines 10-20) b.

submitting the print job to the printer; (28, fig. 2) c. determining whether any text (setup instruction, column 4, line 10-24) has been entered in the instruction field and, (column 4, lines 25-32) if so, placing all print jobs on hold; (print job is hold on 29, fig. 2, before post processor is being set up in 44, fig. 2) d. performing one or more setup operations; (44, fig. 2) and e. entering a code that removes the hold, allowing the print jobs to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet comprising the text (setup instruction) entered in the operator instruction field.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet comprising the text (setup instruction) entered in the operator instruction field.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by

Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 21. Chen et al teach a method of managing a printer system, (fig. 2) comprising the steps of: a. receiving a print job; (29, fig. 2) b. determining that the print job includes operator instructions; (40, fig. 2) c. automatically placing the print job on hold (print job is not passing 44 before post processor is being set up) while allowing other print jobs to continue; (other job is stored in 29, fig. 2) d. performing operations specified by the operator instructions; (44, fig. 2) and e. entering a code that removes the hold, allowing the print job to proceed (the program code that control the branching from 44 to 42, fig. 2).

Chen et al. do not teach printing an instruction sheet corresponding to the operator instructions.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device (column 8, lines 5-15).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet corresponding to the operator instructions;

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily

and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 25: Chen et al. teach a method of coordinate a printer (10, fig. 1) and an associated finishing device (20, 22, column 3, lines 1-10, fig. 1) that is connected to the printer, (10, fig. 1) comprising the steps of: a) receiving, at the printer, a first print job (column 3, lines 17-40); the first print job, before sending to the printer, including received setup instructions (fig. 2, column 2, lines 38-41, column 4, lines 8-35) for at least one finishing device (20, 22, fig. 1) that is associated with the first print job; (b) supplying setup instructions, the instruction listing setup operations associated with the first print job, the setup operations to be performed on the at least one finishing device prior to completing the print job; (column 4, lines 10-32) c) placing at least the first print job on hold; (the print job is not printed before the setup instructions were presented to the operator, column 4, lines 29-32); and d) entering a release code (the program code that control the branching from 44 to 42, fig. 2) to thereby release the print job from hold and allow the printer to complete the print job (column 3, lines 23-25)

Chen et al. do not teach printing an instruction sheet listing setup operations, and receiving at the printer, the setup instructions as part of the printing job.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: using the printer of Chen for printing an instruction sheet listing setup operations. (After the combining of Chen and Ikegaya, the printer of Chen would be used to print an instruction sheet listing setup operations supply from a host. Therefore, the printer would receive the setup instructions as part of the printing job).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Regarding claim 29: Chen teaches placing at least the first print jobs on hold comprising placing all print jobs on hold. (See the operator performs the hardware setup first before print job is being sent. When the operator does not received setup instruction and does not setup hardware, print jobs are not sent)

Regarding claim 30: Chen teaches placing at least the first print jobs on hold comprising placing on hold any print jobs that require using the at least one finishing device that is associated with the first print job. (See the operator performs the hardware setup first before a print job is being sent. When the operator does not received setup instruction and does not setup hardware, print jobs are not sent)

4. Claims 3, 4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) and Matysek et al. as applied to claims 1, 5, above, and further in view of Yamada (U.S. Patent # 5,798,738).

Regarding claims 3, and 7: Chen et al. in view of Ikegaya et al. and Matysek do not teach wherein the print job is entered through a network.

Yamada teaches to enter print jobs (column 5, lines 60-61, column 14, line 2) to a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by entering the print job through a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by the teaching of Yamada because of the following reasons (a) it would have allowed

users to sent print jobs to remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to send print jobs to different printers; and (c) it would have allowed users to print the print jobs with other printers while a printer is down in the network.

Regarding claims 4, and 8: Chen et al. in view of Ikegaya et al. and Matysek do not teach wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

Yamada teaches a printer which is a stand-alone unit including a scanner that provides image data to the printer (fig. 13 A, column 4, lines 15-25, column 5, line 6).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by replacing the printer with a printer which is a stand-alone unit including a scanner that provides image data to the printer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. and Matysek by the teaching of Yamada because of the following reasons (a) it would have allowed the printer to scan images for uses; (b) adding scanning functions to the printer would have provided addition functions to be used by users and thereby, increase the usability of the printing system.

5. Claims 11, 12, 15, 16, 19, 20, 23, 24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) as applied to claims 9, 13, 17, and 21 above, and further in view of Yamada (U.S. Patent # 5,798,738).

Regarding claims 11, 15, and 27: Chen et al. in view of Ikegaya et al. do not teach wherein the print job is received from a network.

Yamada teaches to receive print jobs (column 5, lines 60-61, column 14, line 2) by a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by receiving the print job through a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed users to print jobs using remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to print jobs to different printers; and (c) it would have allowed users to print jobs with other printers while a printer is down in the network.

Regarding claims 12, 16, 20, 23, and 28: Chen et al. in view of Ikegaya et al. do not teach wherein the printer is a stand-alone unit including a scanner that provides image data to the printer.

Yamada teaches a printer which is a stand-alone unit including a scanner that provides image data to the printer (fig. 13 A, column 4, lines 15-25, column 5, line 6).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by replacing the printer with a printer which is a stand-alone unit including a scanner that provides image data to the printer.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed the printer to scan images for uses; (b) adding scanning functions to the printer would have provided addition functions to be used by users and thereby, increase the usability of the printing system.

Regarding claims 19 and 24: Chen et al. in view of Ikegaya et al. do not teach wherein the print job is set up on a network.

Yamada teaches to set up print jobs (column 5, lines 60-61, column 14, line 2) to be printed by a printer (server MFP, column 5, lines 60-61, column 3, lines 60-61) through a network (column 3, line 51).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by setting up the print job on a network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. in view of Ikegaya et al. by the teaching of Yamada because of the following reasons (a) it would have allowed users to print jobs using remote printers, and thereby allowing users to communicate in far apart distances; (b) it would have allowed users to print jobs to different printers; and (c) it would have allowed users to print jobs with other printers while a printer is down in the network.

6. Claims 10, 14, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent # 5,822,506) in view of Ikegaya et al. (U.S. Patent # 5,263,129) as applied to claims 9, 13, 17, and 21 above, and further in view of Olarig (U.S. Patent # 5,878,237).

Regarding claims 10, 14, 18, and 22: Chen et al. do not teach wherein at least some of the instructions for setup operations are stored on a memory.

Ikegaya teaches to store the setup instructions in a memory (column 3, lines 1-10)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. by: storing the setup instructions in a memory

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al. by the teaching of Ikegaya because of the following reasons: (a) storing the setup instruction by a memory would have prevented the setup instruction being lost, and users would save time for not having to write the setup instruction every time the system is to be setup.

Chen et al as modified by Ikegaya still do not teach storing the instructions in a local disk.

Olarig teaches to use a local disk as a memory for storing information (column 15, lines 15-20).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al as modified by Ikegaya by: replacing the memory used to store the setup instruction by a local disk.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the print system of Chen et al as modified by Ikegaya by the teaching of Olarig because of the following reasons: (a) a hard disk would have allowed the printer system to save data from losing even when the power to the system is being turned off; and (b) a hard disk is more durable compared to a tape of a floppy disk, and thereby, allowing the system to last longer.

Allowable Subject Matter

7. Claims 2, 6, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Chen et al in view of Ikegaya et al. do not teach: a) accessing a database of internal setup instructions/setup instructions that are to be performed on the at least one finishing device; b) retrieving a file from the database containing instructions for the at least one finishing device; and translating the file into a page description file that is rasterized and incorporated into the printed instruction sheet, as claimed in claim 26. Claims 2, and 6 has similar features.

Response to Arguments

8. Applicant's arguments filed 4/25/2002 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do combine Chen and Ikegaya is found in the references themselves and in the knowledge generally available to one of ordinary skill in the art.

Chen et al. do not teach printing an instruction sheet listing setup operations.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

With respect to applicant's argument that removing setup data at the printer before it reaches a finishing device would have to modified Chen's operation because control data would be eliminated at the post processor, has been considered.

In reply: The setup data and the control data are different. Setup data are data instructing an operator to set up the finishing devices (column 4, lines 17-33) and control data are data controlling how the finishing devices are to be used. (Column 4, lines 50-67, column 5, lines 1-10,

column 3, lines 25-32). The examiner does not see how the modification of the setup data would affect the operation on the control data.

With respect to applicant's argument that none of the references teach printing setup instructions for a finishing device, has been considered.

In reply: Chen et al. teach a method of performing setup operations (column 3, lines 1-10, column 4, line 29) on a finishing device (20, 22, column 3, lines 1-10, fig. 1) connected to an electrophotographic printer, (10, fig. 1) the printer comprising the steps of: a) entering a print job (column 3, lines 17-40) into the printer, the print job including setup instructions (fig. 2, column 2, lines 38-41, column 4, lines 8-35) for at least one finishing device (20, 22, fig. 1) written as an operator message; (column 4, lines 4-25) b) automatically supplying setup operations to be performed prior to completing the print job. (column 4, lines 10-20)

Chen et al. do not teach printing an instruction sheet listing setup operations.

Ikegaya, in the same area of user modifying printing devices, (column 1, lines 30-55), teaches printing an instruction sheet listing setup operations instructing users of how to setup the printing device. (column 8, lines 5-15)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by: printing an instruction sheet listing setup operations.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chen's printing system by the teaching of Ikegaya because

of the following reasons: (a) it would have allowed a user to setup various functions very easily and in a short time; as taught by Ikegaya, at column 8, lines 15-20; (b) it would allow users to avoid alternately looking at a manual to an operation panel for setting up the devices; as taught by Ikegaya, at column 1, lines 45-50; and (c) a printed instruction sheet is more easily to carry compare to a display monitor displaying the instructions.

Action is Final, Necessitated by Amendment

9. Applicant's amendment necessitated the new ground of rejection presented in this office action. Therefore, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTHS shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

June 21, 2002

GABRIEL GARCIA
PRIMARY EXAMINER